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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,086	07/21/2003	Arthur Ho	D-2895CIP2	6002

33197 7590 12/14/2004

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,086

Applicant(s)

HO ET AL.

Examiner

Jordan M. Schwartz

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AS

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/8/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

For applicant's information, the reference Roffman et al 5,861,114 on page 3 of the IDS was crossed out because this reference is already listed on page 1 of this IDS.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-9, 11-15, 17-21, 31-34, 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Lieberman et al patent number 5,880,809.

Lieberman et al reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract) comprising a lens body including a silicone hydrogel (column 15, lines 52-62); one of the anterior or posterior surface as a substantially smooth junctionless (Figures 8-9, column 11, lines 34-66); three dimensional asymmetrical surface (column 3, line 32 to column 4, line 11, column 11, lines 34-66); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 11, lines 34 to column 12, line 8 re substantially junctionless and Figures 8-9 which disclose the thickness of the lens varying radially and column 12, lines 1-7

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re the peripheral portion shaped in the form of an S-curve which will cause the thickness of the peripheral portion to vary radially); the varied surface topography facilitating lens comfort (column 12, lines 1-7); the posterior and/or anterior surface as the substantially junctionless three dimensional surface (column 5, line 1 to column 8, line 52). Furthermore, with respect to the anterior surface, Lieberman et al discloses that the anterior surface can be a blended toric surface (column 10, lines 15-32). A toric surface will inherently be three dimensionally asymmetrical and a blended surface will inherently be smooth. Lieberman et al further discloses the lens body including a toric surface to correct an astigmatism (column 2, line 53, column 10, line 18); the posterior surface to approximate the curvature of the cornea (column 14, line 62); the lens including a multifocal optical zone (column 15, line 33); the lens body including a hydrophilic silicone polymer or a silicone hydrogel (column 15, lines 52-62). The hydrophilic silicone polymer of Lieberman et al will inherently include monomers selected from the group of claims 13-14, this being reasonably based upon the type of materials for the lens disclosed in Lieberman et al (column 15, lines 52-62). The lens of Lieberman et al will inherently maintain a uniform distance between the corneal surface and the lens, this being reasonably based upon the similarity in structure between the lens of Lieberman et al and that of the claimed invention.

Claims 11-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Townsley patent number 5,020,898.

Townsley reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract) comprising a lens body including

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a hydrophilic silicone polymer or silicone hydrogel (column 1, lines 42-52); the lens body having a toric surface (column 2, lines 35-44); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 2, lines 35-68 i.e. the thickness tapering in a smooth curve and Figures 2-4 which discloses the thickness varying radially); the varied surface topography facilitating lens comfort (column 2, lines 35-44); the lens structured to correct an astigmatism of the eye (abstract); and the varied surface topography provided on the anterior surface of the lens (column 2, line 45 to column 3, line 12). The lens of Townsley will inherently include monomers selected from the group of claims 13-14, this being reasonably based upon the type of materials for the lens disclosed (column 1, lines 42-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 16, 23-29, 35, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman et al.

Lieberman discloses as is set forth above but does not specifically disclose the lens including a ballast by a varied anterior and/or posterior surface. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for such lenses to have a varied anterior and/or posterior surface

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defining a ballast for the purpose of providing improved lens stability on the eye.

Furthermore, Lieberman teaches that contact lenses can comprise a ballast for the purpose of providing increased lens stability (column 15, lines 8-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman et al as having a varied anterior and/or posterior surface defining a ballast since such a structure is well known in the art of contact lenses and is further taught by Lieberman with respect to prior art lenses for the purpose of providing a lens of improved stability on the eye.

Claims 10, 22, 30, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman et al in view of Roffman et al patent number 6,554,425.

Lieberman et al discloses as is set forth above but does not disclose the lens body configured to correct or reduce a wavefront aberration of a patient's eye. Roffman et al teaches that in contact lenses it is desirable to configure the lens to reduce wavefront aberration of a patient's eye for the purpose of providing a lens of improved aberration correction (column 1, line 57 to column 2, line 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman et al as configured to correct or reduce a wavefront aberration of a patient's eye since Roffman et al teaches that in contact lenses it is desirable to configure the lens to reduce wavefront aberration of a patient's eye for the purpose of providing a lens of improved aberration correction.

Prior Art Citations

Barsky patent number 6,241,355, Miyamura et al patent number 6,659,607, Roffman et al patent number 5,650,838, and Mancini et al patent number 4,401,372 are being cited herein to show contact lenses that either alone or with a teaching reference would have made obvious a number of the claims of the claims 11 and 31 embodiments, however such rejections would have been repetitive. For example, Barsky discloses the limitations of claims 11 and 31 but does not specifically disclose the lens as a hydrophilic silicone polymer and there are many contact lens teachings as to the advantages of such materials in contact lenses for improved comfort.

Back, patent number 6,467,903 is being cited herein for support that it is well known in the art of contact lenses for such lenses to have a varied anterior and/or posterior surface defining a ballast for the purpose of providing improved lens stability on the eye (see column 1, lines 50-63).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
December 8, 2004